

REMARKS

Claims 1 through 60 are pending in this reissue application. The Applicant appreciates the allowance of claims 1-10 and 49-54.

The Office action mailed on 4 June 2002 (Paper No. 5) provided by the Examiner has been read and given careful consideration.

The Examiner relies upon the following reference:

Bang

U.S. Pat. No. 5,870,086

9 February 1999

In Paper No. 5, the Examiner rejects claims 11, 12, 17, 18, 21, 22, 25, 26, 31, 32, 35, 38, 43, 46, 55, and 56 under 35 U.S.C. § 102(e) as being anticipated by Bang '086. Additionally, the Examiner rejects claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, and 57-60 under 35 U.S.C. § 103(a) as being unpatentable over Bang '086 in view of the Applicant's supposed admitted prior art. The Applicant respectfully submits that these rejections are improper and should be withdrawn, because Bang '086 is not valid "prior art."

The Applicant respectfully submits that Bang '086 is not available to cite as "prior art" in a rejection of claims of the present reissue application for the following two reasons: firstly, the effective U.S. filing date of the present reissue application, 10 March 1997, is earlier than the effective U.S. filing date of Bang '086, 14 August 1997; and secondly, the foreign priority filing

date of the present reissue application, 8 March 1996, is perfected and is earlier than the effective U.S. filing date of Bang '086, 14 August 1997.

1.

Firstly, the effective U.S. filing date of the present reissue application is 10 March 1997 which is earlier than the Bang '086 U.S. filing date of 14 August 1997, and therefore Bang '086 is not valid "prior art." The present reissue application is an application for reissue of U.S. Pat. No. 5,944,830 issued to Hong et al. (Hong '830) on 31 August 1999. Hong '830 was filed in the U.S. on 10 March 1997 and claimed foreign priority based on the following two Korean applications filed on 8 March 1996: 1996-4299 and 1996-6135.

M.P.E.P. § 706.02 states "The effective filing date of a U.S. application may be determined as follows: (A) If the application is a continuation or divisional of one or more earlier U.S. applications and if the requirements of 35 U.S.C. § 120 have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications (C) If the application claims foreign priority under 35 U.S.C. § 119(a)-(d), the effective filing date is the filing date of the U.S. application, unless situation (A) or (B) as set forth above applies. The filing date of the foreign priority document is not the effective filing date, although the filing date of the foreign priority document may be used to overcome certain references. See M.P.E.P. § 706.02(b) and § 2136.05."

If a reference cannot be relied upon as prior art to reject a claim under 35 U.S.C. § 102 in a particular case, then that reference cannot be relied upon as prior art to reject the claim under 35 U.S.C. § 103.

In view of the foregoing, the Applicant respectfully submits that Bang '086 is not valid prior art in this case. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejections of claims under §§ 102 and 103.

2.

Secondly, the foreign priority filing date of the present reissue application, 8 March 1996, is perfected and is earlier than the effective U.S. filing date of Bang '086, 14 August 1997, and therefore Bang '086 is not valid "prior art."

The present reissue application is an application for reissue of the following original patent: U.S. Pat. No. 5,944,830 issued to Hong et al. (Hong '830) on 31 August 1999. Hong '830 was filed in the U.S. on 10 March 1997 and claimed foreign priority based on a first Korean application number 1996-4299 filed on 8 March 1996 and based on a second Korean application number 1996-6135 also filed on 8 March 1996. In support of this statement, Applicant is submitting herewith English language translations of the aforesaid two Korean priority documents (1996-6135 and 1996-4299), and the statement by the translator affirming that the translations are true and accurate.

M.P.E.P. § 706.02(b) states “A rejection based on § 102(e) can be overcome by: ... (E) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d). The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 C.F.R. § 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. § 112, first paragraph.”

According to M.P.E.P. § 706.02(b), one requirement that must be satisfied to overcome a § 102(e) rejection is that the foreign priority date must antedate the reference. This aspect of M.P.E.P. § 706.02(b) is satisfied because the filing date of the two foreign priority documents is 8 March 1996 which antedates the U.S. filing date of Bang '086 14 August 1997.

37 C.F.R. § 1.55(a)(4) states “An English language translation of a non-English language foreign application is not required except when ... necessary to overcome the date of a reference relied upon by the examiner.... If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.”

According to M.P.E.P. § 706.02(b), one requirement that must be satisfied to overcome a § 102(e) rejection is that the foreign priority date must be perfected. According to 37 C.F.R. § 1.55(a)(4), an English language translation should be filed together with a statement that the

translation of the certified copy is accurate. These aspects of M.P.E.P. § 706.02(b) and 37 C.F.R. § 1.55(a)(4) are satisfied because enclosed with this Supplemental Reply are the following four documents:

- * An English translation of Korean Patent Application No. 1996-6135 entitled *POWER MANAGEMENT APPARATUS FOR MONITOR* filed on 8 March 1996.
- * A statement confirming the accuracy of the English translation of Korean Patent Application No. 1996-6135.
- * An English translation of Korean Patent Application No. 1996-6135 entitled *OFF MODE INDICATING CONTROL CIRCUIT FOR MONITOR* filed 8 March 1996.
- * A statement confirming the accuracy of the English translation of Korean Patent Application No. 1996-6135.

M.P.E.P. § 1417 states "A 'claim' for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application on which the original patent was granted. However, no additional certified copy of the foreign application is necessary."

The certified priority documents for Korean application numbers 1996-4299 and 1996-6135 were filed with the U.S. Patent and Trademark Office in conjunction with the prosecution/issuance of U.S. Pat. No. 5,944,830 (Hong '830), which corresponds to the parent of the present reissue application. The U.S. Patent and Trademark Office acknowledged receipt of

the two certified priority documents in the Office action (Paper No. 4) mailed 13 October 1999 for U.S. Serial No. 08/814,502. The U.S. Serial No. 08/814,502 was issued to Hong et al. on 31 August 1999 and corresponds to U.S. Pat. No. 5,944,830. In accordance with M.P.E.P. § 1417, no additional certified copies of the foreign applications are necessary.

If a reference cannot be relied upon as prior art to reject a claim under 35 U.S.C. § 102 in a particular case, then that reference cannot be relied upon as prior art to reject the claim under 35 U.S.C. § 103.

In view of the foregoing, the Applicant respectfully submits that Bang '086 is not valid prior art in this case. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejections of claims under §§ 102 and 103.

3.

In the Office action mailed 4 June 2002 (Paper No. 5), on pages 4-5, the Examiner relies upon "Applicant's Admitted Prior Art (AAPA)" in the § 103 rejection of claims.

The Examiner alleges that features discussed by the Applicant in the section entitled "Description of Related Art" are considered by the Examiner to be "Applicant's Admitted Prior Art." The Applicant respectfully objects to this allegation because the related art set forth by the Applicant is not an admission of prior art.

The related art includes a discussion of the Applicant's view of some background information that may be of assistance to a reader, to facilitate understanding of the present invention. The Applicant respectfully submits that features and subject matter in the section entitled "Description of Related Art" constitute related art only, and do not constitute admitted prior art. When the Applicant describes "related art" this does not constitute an admission that the "related art" is actually "prior art."

The term "related art" is not equivalent to the term "prior art." The term "prior art" is defined by the statute, namely 35 U.S.C. § 103 which defines the term "prior art" by reference to 35 U.S.C. § 102.

The Applicant respectfully requests that the Examiner adhere to the guidelines dictating that "related art" is not equivalent to "admitted prior art." The Applicant respectfully requests that the Examiner withdraw the label of "Applicant's Admitted Prior Art" from the related art set forth in the present application.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No. 27,774

1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

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I.D.: REB/DC